

REMARKS

The present application has been reviewed in light of the Office Action dated November 20, 2009. Claims 3-11 are presented for examination, of which Claim 3 is in independent form. Favorable reconsideration is requested.

The Office Action rejects Claims 3-11 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, pages 2 and 3 of the Office Action state that the terms “communicatively coupled”, “a common file structure”, “a partner file structure”, and “write access” in Claim, 3, and the phrase “read access” in Claim 11 are not “in juxtaposition with the descriptive portion of the specification and drawing figures”.

In response, Applicants submit that these terms in Claims 3-11 are fully supported by the original disclosure and that Claims 3-11 fully satisfy 35 U.S.C. § 112, second paragraph. For the Examiner’s convenience, Applicants provide below the correspondence between the portions of the specification, using the published version of the application (U.S. Patent Publication No. 2005/0038741), and the claim language objected to in the Office Action. However, it should be understood that the corresponding portions of the specification and drawings noted below are merely examples of the claimed elements and that the corresponding claimed elements are not limited to the elements and passages noted in the specification.

The communicative coupling of the transponder and its database to the transponder reader is supported, for example, at least by Figures 1A, 2, and 16 and the following paragraphs: [0034] (“...fob 102...may be interrogated by RFID reader 104...”); [0035] (“...a RFID reader 104 in RF communication with fob 102...”); [0042] (“Fob 102 may include an antenna 202 for receiving an interrogation signal from RFID reader 104 via antenna 106 (or alternatively, via

external antenna 108). Fob antenna 202 may be in communication with a transponder 114.”... The transponder 114 may be in communication with a transponder compatible modulator/demodulator 206 configured to receive the signal from transponder 114 and configured to modulate the signal into a format readable by any later connected circuit. Further, modulator/demodulator 206 may be configured to format (e.g., demodulate) a signal received from the later connected circuitry in a format compatible with transponder 114 for transmitting to RFID reader 104 via antenna 202.”); [0179] (“...reservation EF 1618 comprises a plurality of records having the structure shown in Table 31 below. In general, this EF may be used to store confirmation numbers transmitted to fob 102 when the fob user makes a reservation at a given hotel (designated in the property code field”); [0199] (“...fob 102 communicates with RFID reader 104 provided at POS device 110, and suitable communications are made between transponder 114 on fob 102 and RFID reader 104 according to the methods described herein.”) and [0205] (“...the associated confirmation number supplied by the hotel may be downloaded into the confirmation number field in reservation EF 1618 along with the date and the property code of the hotel. This step might require the fob user to transmit appropriate credit card account information, which may be suitably retrieved from pay1 EF 1304.”).

The “common file structure” recited in Claim 3 is supported, for example, at least by Figures 1A, 2, and 14-16 and the following paragraphs: [0160] (“common DF 1402”); [0162] (“Common DF 1402 generally includes data accessible to all participating airlines...”); and [0163] (“Common DF 1402 suitably comprises common data which would be of use to any of the various partnering airlines, i.e., passenger EF 1406, frequent flier EF 1408, IET EF 1410, boarding EF 1412, and biometric EF 1414.”).

The “partner file structure” recited in Claim 3 is supported, for example, at least by Figures 1A, 2, and 14-16 and the following paragraphs: [0124] (“...sophisticated access and encryption schemes are, in one embodiment, utilized in order to allow multiple parties to make use of certain file structures while preventing unauthorized entry into others. More specifically, partnering organizations (e.g., hotel chains, airlines, and rental car agencies) may create their own tailor-made file structures (i.e., “partner file structures”) within fob 102.”); [0162] (“...issuer DF 1404 generally includes data which can only be read or written to by the fob issuer. Airline application 1010, in one embodiment, further comprises at least one (may be three) additional DF 1403 for use by airline partnering organizations. That is, one airline partner may have access to and specify the structure of data stored within DF 1403(a) (as well as common EF 1402), while another airline might have similar access to DF 1403(b).”); and [0203] – [0209], which provide many examples of read and write access between a partner organization and the fob 102.

The “write access” recited in Claim 3 is supported, for example, at least by Figures 1A, 2, and 14-16 and the following paragraphs: [0050] (“Track 3 may be unique in that track 3 was intended to have data read and WRITTEN on it.”); [0162] (“Common DF 1402 generally includes data accessible to all participating airlines, while issuer DF 1404 generally includes data which can only be read or written to by the fob issuer.”); [0163] (“Issuer DF 1404, in contrast, comprises information readable by all, but updateable only by the card issuer, i.e., preferences EF 1416, PIN EF 1418, and issuance EF 1420”); [0177] (“Common DF 1614 comprises reservation EF 1618, expenses EF 1616, key-of-the-room EF 1610, and preferences EF 1612.”); and [0179] (“...reservation EF 1618...may be used to store confirmation numbers transmitted to fob 102 when the fob user makes a reservation at a given hotel...”).

The “read access” recited in Claim 11 is supported, for example, at least by Figures 1A, 2, and 14-16 and the following paragraphs: [0040] (“...the account number may include a unique fob serial number and user identification number, as well as specific application applets. The account number may be stored in fob 102 inside a database 214, as described more fully below.”); [0046] (“...protocol/sequence controller 208 may be in communication with a database 214 for storing at least a fob 102 account data, and a unique fob 102 identification code. Protocol/sequence controller 208 may be configured to retrieve the account number from database 214 as desired. Database 214 may be of the same configuration as database 212 described above. The fob account data and/or unique fob identification code stored on database 214 may be encrypted prior to storage. Thus, where protocol/sequence controller 208 retrieves the account data, and or unique fob identification code from database 214, the account number may be encrypted when being provided to RFID reader 104. Further, the data stored on database 214 may include, for example, an unencrypted unique fob 102 identification code, a user identification, Track 1 and 2 data, as well as specific application applets.”); [0082] (“Personalization system 116 may populate (e.g., inject) the encrypted fob 102 account number into fob database 214 for later providing to authenticated RFID reader 104.”); [0097] (“The fob protocol/sequence controller 208 may then retrieve from database 214 an encrypted fob account number and provide the encrypted account number to the RFID reader 104 (step 820).”); [0117] (“It will be appreciated by those skilled in the art that the term “application” in this context refers to self-contained regions of data all directed at a particular function (e.g., airline, hotel, etc.) rather than a block of executable software code, although the use of executable modules as part of any particular application falls within the scope of the present invention.”); [0119] (“Fob user ID application 1006 suitably comprises various files related to personal information of the fob

user (e.g., name, addresses, payment accounts, driver's license, personal preferences and the like). Fob user ID application 1006 may also comprise various files relating to transponder 114, including a transponder identifier. The phrases "fob user identification" and "transponder user identification" may be used interchangeably. Fob user ID application 1006 may be described in greater detail below in conjunction with FIG. 11.”); and [0138] (“Referring now to FIG. 11, Fob user ID application 1006 may be used to store various information related to the fob user. Portions of this information are freely available to the partnering organizations, thereby preventing the storage of redundant information.”).

In view of the support in the specification and drawings for the terms “communicatively coupled”, “a common file structure”, “a partner file structure”, and “write access” in Claim, 3, and the phrase “read access” in Claim 11 noted above, Applicants respectfully submit that Claims 3-11 satisfy 35 U.S.C. § 112, second paragraph. Therefore, Applicants respectfully request that this rejection be withdrawn.

Claims 3-11 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,952,156 (*Arshad et al.*). The Office Action appears to admit that the *Arshad et al.* patent lacks the claimed transponder user identification application and second application. For that reason, page 3 of the Office Action takes Official Notice that “airline and hotel applications have been common knowledge in the database art.”. Page 3 of the Office Action then concludes that to have provided such for a database of the patent to *Arshad et al.* would appear to have been obvious to the skilled artisan.

Applicants respectfully traverse the rejection for the following reasons.

Claim 3 relates to a transponder communicatively coupled to a transponder-reader to perform a transaction. The transponder comprises a database that stores travel-related

information and is communicatively coupled to the transponder-reader. The travel-related information comprises a transponder user identification application and a second application that stores travel-related information of a transponder user. The second application comprises a common file structure and a partner file structure. The partner file structure provides write access to a field within the partner file structure for a first partnering organization and denies write access to the field for a second partnering organization. The common file structure provides write access for both the first and second partners to at least one field in the common file structure.

One non-limiting example of the common file structure and the partner file structure is shown in Figure 14. This figure shows a common DF 1402 that includes data accessible to all participating airlines, such as passenger data, frequent flyer data, boarding data, and biometric data. This figure also shows a DF 1404 having data that can only be read or written to by the fob issuer; for example, this data can include preference data 1416, PIN data 1418, and issuance data 1420 that are readable by all partner airlines, but are updatable only by the fob issuer. And Figure 14 also shows DF 1403(a) and DF 1403(b), each belonging to a different airline partner, each of which having exclusive access to and specifying the structure of the data therein. *See* paragraphs [0162] and [0163].

In contrast, Applicants submit that neither the *Arshad et al.* patent, nor conventional airline and hotel applications are understood to disclose or suggest a transponder comprising a database that stores travel-related information comprising a second application that comprises a partner file structure that provides write access to a field within the partner file structure for a first partnering organization and denies write access to the field for a second partnering

organization, and a common file structure that provides write access for both the first and second partners to at least one field in the common file structure, as recited by Claim 3.

As noted above, the Office Action implicitly admits that the *Arshad et al.* patent does not show this feature, and for this reason takes Official Notice that “airline and hotel applications have been common knowledge in the database art.”. However, Claim 3 does not merely claim an airline or hotel application in general. Rather, Claim 3 recites a particular type of transponder database: a database having a partner file structure that provides write access to a field within the partner file structure for a first partnering organization and denies write access to the field for a second partnering organization, and a common file structure that provides write access for both the first and second partners to at least one field in the common file structure. And the Office Action does not allege that the conventional art of which Official Notice is taken discloses such a database. Therefore, the rejection is submitted to be improper, and Claim 3 is submitted to be unobvious, because neither the conventional art of which Official Notice is taken, nor the *Arshad et al.* patent are understood to disclose or suggest the specific application structure recited Claim 3 – a partner file structure that provides write access to a field within the partner file structure for a first partnering organization and denies write access to the field for a second partnering organization, and a common file structure that provides write access for both the first and second partners to at least one field in the common file structure.

Moreover, if the Office Action is taking Official Notice of conventional hotel and airline databases that include both the claimed partner file structure and the claimed common file structure, then Applicants submit that such Official Notice is improper under MPEP §2133.04 for the following reasons.

Under MPEP §2133.04:

[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known...It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. (Emphasis in the original)

Thus, the fact that hotels and airlines possess hotel and airline databases, respectively, could be instantly verified by any member of the public telephoning a hotel or airline or using a computer web browser to retrieve a reservation. But, Applicants submit that such a telephone call or such a web-browser experience could not instantly and unquestionably demonstrate the existence of the specific partner and common file structures recited by Claim 3, since the specific type of file structures used by hotel and airline databases is not evident from public interactions therewith via telephone or web browser. Moreover, the Office Action offers no evidence of the instant and unquestionable demonstration of the Claim 3 file structures in hotel and airline databases. In addition, Claim 3 does not merely recite specific partner and common file structures. It also recites that such file structures are part of a database of a transponder. And there is no evidence of record that the Office has demonstrated the instantly and unquestionable existence of a transponder with the specific partner and common file structures recited by Claim 3.

In the absence of such evidence, the Office is not permitted to base its rejection of Claim 3 on such Official Notice. Therefore, Applicants respectfully request that the Office a) cite a reference showing the facts alleged in the Official Notice, as required by MPEP §2133.04, and

provide a detailed rationale for modifying the *Arshad et al.* patent in view of this additional art to produce the Claim 3 invention, or b) allow Claim 3.

The other rejected claims in this application depend from the independent claim discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim also is deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

In view of the above remarks, the application is in allowable form. Therefore, early passage to issue is respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

/Gary M. Jacobs/

Attorney for Applicants
Registration No. 28,861

FITZPATRICK, CELLA, HARPER & SCINTO
1290 Avenue of the Americas
New York, New York 10104-3800
Facsimile: (212) 218-2200